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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

COPPOLA, JACOB C

ART UNIT	PAPER NUMBER
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3621

NOTIFICATION DATE	DELIVERY MODE
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10/16/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/518,797	Applicant(s) TSUKAZAKI ET AL.	
	Examiner JACOB C. COPPOLA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 14-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20 December 2004 and 15 July 2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is in reply to the Election Response filed on 08 August 2008.
2. Claims 1-26 are currently pending and have been examined.
3. All references to the capitalized versions of “Applicants” refer specifically to the Applicants of record. Any references to lower case versions of “applicant” or “applicants” refer to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to this Office Action and any future office action(s) as well.
4. Applicant’s election of Species A2, B2 (claims 1-13) in the reply filed on 08 August 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
5. The requirement is still deemed proper and is therefore made FINAL.
6. Claims 14-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.
7. This Office Action is given Paper No. 20080924. This Paper No. is for reference purposes only.

Information Disclosure Statement

8. The Information Disclosure Statements filed 20 December 2004 and 15 July 2008 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

11. Regarding claims 1 and 2:

a. These claims are directed to neither a "process" or a "machine" but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.

Accordingly, claims 1 and 2 are rejected under §101.

12. Regarding claims 6 and 12:

b. Based on Supreme Court precedent¹ and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing².

c. In this particular case, the method steps are not tied to another statutory class. For example, the first step recites "transmitting a table", but fails to identify a class of invention that performs the "transmitting". The same argument applies to the remaining

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances; *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972)

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steps of the claim. Therefore, the claimed method is not a patent eligible process under § 101.

13. Regarding claims 7 and 13:

d. As recited, claims 7 and 13 are directed toward “[a] program to be executed by a computer... to carry out processing”. However, under the current guidelines of 35 USC 101, “programs” or software must be tangibly embodied on a computer readable medium, and, when executed by a computer processor, perform the steps of the code. In their broadest reasonable interpretation and in light of the specification, claims 7 and 13, as recited, can be interpreted to be embodied on abstract mediums such as carrier waves and signals, and therefore not eligible for patent protection. Accordingly, claims 7 and 13 are not eligible for patent protection.

Claim Rejections - 35 USC § 112, 2nd Paragraph

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The claims are replete with errors, some examples follow.

16. Regarding claims 1, 8, 12, and 13:

e. These claims recite “making a request for utilization of predetermined contents pertaining to a range to be purchased”. These claims are indefinite because one of

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ordinary skill in the art would not understand whether the “request” pertains to “a range to be purchased” or the “contents” pertain to “a range to be purchased”.

f. Moreover, these claims recite “a request for utilization... by transmission of content IDs... and an electronic point count for purchasing”. These claims are indefinite because it is unclear to one of ordinary skill in the art whether the “request” is “by transmission of content IDs” and by transmission of “an electronic point count” or the “electronic point count” is separate from the request.

g. Moreover, these claims recite “a request for utilization... to be purchased by transmission of content IDs”. These claims are indefinite because it is unclear to one of ordinary skill in the art whether the “request” is “by transmission of content IDs” or the purchase is “by transmission of content IDs”.

h. Moreover, these claims recite “an electronic point count for purchasing said predetermined contents to said server”. These claims are indefinite because it is unclear to one of ordinary skill in the art how an electronic point count would allow purchasing *to* a server.

i. Moreover, these claims recite “receiving a table... and a utilization condition transmitted by said server”. These claims are indefinite because it is unclear to one of ordinary skill if both the table and the utilization condition are transmitted from the server or if the utilization condition alone is transmitted from the server.

17. Regarding claims 1, 2, 6, and 7:

j. These claims recite “transmitting said table associating content IDs with said electronic point count and said utilization condition for utilizing said predetermined

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contents”. These claims are indefinite because it is unclear to one of ordinary skill whether the table associates content IDs with the electronic point count and the utilization condition or the table associates content IDs with only the electronic point count. It is also unclear, to one of ordinary skill in the art, whether the “transmitting” is directed to the table with associated electronic point count and associated utilization condition or if the “transmitting” is directed to the table with only an associated electronic point count and also directed to the utilization condition that is not associated with the table.

k. Moreover, these claims recite “predetermined contents pertaining to said range as contents”. These claims are indefinite because one of ordinary skill in the art would not understand how contents pertain to a range as contents.

18. Regarding claims 1 and 2:

l. These claims are indefinite because they are considered hybrid claims. See MPEP §2173.05(p) II. In particular, the claims are directed to neither a "process" or a "machine" but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.

m. For example, claim 1 recites “a content providing system”, “a terminal”, “a server”, “request means”, and “reception means”. In light of this evidence, one of ordinary skill in the art could reasonably interpret these recitations as express intent by Applicants to claim a machine claim. Alternatively, claim 1 recites “in a process to update said electronic point count of said table ... said server further transmits a content ID... updates said table on the basis of said content ID”. One of ordinary skill in the art could also reasonably interpret these recitations as express intent by Applicants to claim a

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process claim. In light of this conflicting evidence, a person of ordinary skill in the art could reasonably interpret claim 1 to be drawn to either a product or process.

n. Therefore in accordance with §2173.05(p) II which states that a single claim must be drawn to either a product or process (but not both) and because a potential competitor of Applicants would not know whether *possession alone* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution* of the recited method steps, the claims are indefinite. If Applicants overcome this particular 35 U.S.C. §112, 2nd paragraph rejection, the related 35 U.S.C. §101 rejection will also be withdrawn.

19. Regarding claims 1-13:

o. The phrase "electronic point count" is indefinite because—to one of ordinary skill in this art—the metes and bounds of the phrase can not be reasonably determined. First, the Examiner has carefully reviewed the original specification and can not locate, let alone ascertain, a lexicographic definition for this phrase. Second, the Examiner has again reviewed all documents of record in conjunction with MPEP §2141.03. Based upon this review and the review of the original specification, it is the Examiner's position that the phrase "electronic point count" (as used in the context of these particular claims) is not known to those of ordinary skill in this art. However, if Applicants believe that the phrase *is* old and well known in the art, Applicants should (in their next appropriately filed response) expressly state on the record that the phrase is old and well known in the art and provide appropriate evidence in support thereof (*e.g.* a U.S. patent). Upon receiving (1) Applicants' express statement that the phrase is old and well known in the

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art and (2) sufficient evidence in support thereof, the Examiner will withdraw this particular 35 U.S.C. §112, 2nd paragraph rejection.

20. Regarding claims 1-5 and 8-11:

p. The following claim elements are means-plus-function limitations that invoke 35 U.S.C. 112, 6th paragraph (as shown below). However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function.

- i. *storage means for storing said contents;*
- ii. *request means for making a request for utilization of predetermined contents;*
- iii. *reception means for receiving a table;*
- iv. *utilization-condition storage means for storing said utilization condition and said table;*
- v. *utilization execution means for executing utilization of said predetermined contents;*
- vi. *utilization-condition transmission means for transmitting said table;*
- vii. *sales-history information storage means for storing sales-history information of said predetermined contents;*
- viii. *collection means for collecting sales records of contents utilized by said terminal;*
- ix. *processing execution means for carrying out processing based on said sales records;*
- x. *acquisition means for acquiring execution-history information;*

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- xi. *utilization-history information storage means for storing utilization-history information;*
- xii. *favorite extraction means for extracting information of contents;*
- xiii. *execution-history information storage means for storing execution-history information; and*
- xiv. *execution-history information transmission means for transmitting said execution-history information.*

q. The Examiner has searched the original specification for the terms of the above limitations (e.g. storage means, request means, etc.) and is unable to locate a description of each term that describes the specific structure referenced by the “means for” language.

21. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 102

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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23. Claims 1-13, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Ishibashi (E.P. 1,128,598 A1) ("Ishibashi").

24. Regarding claims 1, 2, 6-8, 12, and 13:

r. Ishibashi discloses the following limitations:

xv. *storage means* (KIOSK terminal server **357**) *for storing said contents in advance* (see ¶0728);

xvi. *request means* (inputting means **355**) *for making a request for utilization of predetermined contents pertaining to a range to be purchased by transmission of content IDs identifying said predetermined contents among a plurality of said contents stored in said storage means and an electronic point count for purchasing said predetermined contents to said server (hosting server **331**)* (see ¶0729);

xvii. *reception means* (communication section **350**) *for receiving a table associating said content IDs with said electronic point count and a utilization condition transmitted by said server at said request made by said request means* (see ¶0723);

xviii. *utilization-condition storage means* (KIOSK terminal server **357**) *for storing said utilization condition and said table, which are received by said reception means* (see ¶0728);

xix. *utilization execution means* (control section **360**) *for executing utilization of said predetermined contents on the basis of said utilization condition and said*

table, which have been stored in said utilization-condition storage means (see ¶0735);

xx. *utilization-condition transmission means (hosting server 331) for transmitting said table associating said content IDs with said electronic point count and said utilization condition for utilizing said predetermined contents pertaining to said range as contents, utilization of which is requested by said request means employed in said terminal, to said terminal (see ¶0728);*

xxi. *sales-history information storage means (history data management section 15) for storing sales-history information of said predetermined contents pertaining to said range as information including said content IDs identifying said predetermined contents, utilization of which is requested by said request means employed in said terminal (see ¶0227, figure 2, figure 97, and associated text);*

xxii. *collection means (user management section 18) for collecting sales records of contents utilized by said terminal on the basis of said sales-history information stored in said sales-history information storage means (see ¶0227, figure 2, figure 97, and associated text); and*

xxiii. *processing execution means (history data management section 15) for carrying out processing based on said sales records (see ¶0227, figure 2, figure 97, and associated text); and*

xxiv. *in a process to update said electronic point count of said table, said utilization-condition transmission means employed in said server further*

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transmits a content ID, said electronic point count of which is to be updated, and an update of said electronic point count whereas said utilization-condition storage means employed in said terminal updates said table on the basis of said content ID and said update of said electronic point count, which are received from said server (see at least figure 75 and associated text).

25. Regarding claim 3:

s. Ishibashi discloses the limitations of claim 2, as shown above. Ishibashi, further, discloses the following limitations:

xxv. *wherein said sales-history information stored in said sales-history information storage means further includes an apparatus ID used for identifying said terminal (see at least ¶0405).*

26. Regarding claim 4:

t. Ishibashi discloses the limitations of claim 2, as shown above. Ishibashi, further, discloses the following limitations:

xxvi. *acquisition means for acquiring execution-history information representing a history of executions of utilizations of said contents stored in said terminal (see at least figure 2, figure 96, figure 99, and associated text); and*

xxvii. *utilization-history information storage means for storing utilization-history information including said content ID received from said server and said execution-history information acquired by said acquisition means, wherein said collection means further collects utilization records of contents utilized by said*

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terminal on the basis of said utilization-history information (see at least figure 2, figure 96, figure 99, and associated text).

27. Regarding claim 5:

u. Ishibashi discloses the limitations of claim 2, as shown above. Ishibashi, further, discloses the following limitations:

xxviii. favorite extraction means for extracting information of contents each serving as a favorite with a user using said terminal on the basis of said utilization-history information stored in said utilization-history information storage means and information on favorites stored in said terminal, wherein said transmission means transmits information extracted by said favorite extraction means as said information of contents each serving as a favorite with said user using said terminal to said terminal (see at least figure 2, figure 96, figure 99, and associated text).

28. Regarding claim 9:

v. Ishibashi discloses the limitations of claim 8, as shown above. Ishibashi, further, discloses the following limitations:

xxix. ID storage means for storing an apparatus ID used for identifying said information-processing apparatus, wherein said request means transmits said apparatus ID from said ID storage means along with said content IDs of said predetermined contents pertaining to said range to be purchased and said electronic point count for purchasing said predetermined contents in order to

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make said request for utilization of said predetermined contents pertaining to said range (see at least figure 2, figure 96, figure 99, and associated text).

29. Regarding claim 10:

w. Ishibashi discloses the limitations of claim 8, as shown above. Ishibashi, further, discloses the following limitations:

xxx. *execution-history information storage means for storing execution-history information representing a history of executions of utilizations of said predetermined contents; and execution-history information transmission means for transmitting said execution-history information stored in said execution-history information storage means to said server (see at least figure 2, figure 96, figure 99, and associated text).*

30. Regarding claim 11:

x. Ishibashi discloses the limitations of claim 8, as shown above. Ishibashi, further, discloses the following limitations:

xxxi. *said reception means further receives information on favorite contents of a user using said information-processing apparatus from said server as information based on said execution-history information; and said utilization execution means executes utilizations of said predetermined contents on the basis of said information on favorite contents (see at least figure 2, figure 96, figure 99, and associated text).*

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31. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

32. In light of Applicants' choice to pursue product claims, Applicants are reminded that functional recitation(s) using the word and/or phrases "for", "adapted to", "configured to", or other functional language (*e.g.* see claim 1 which recites "a request for utilization of predetermined contents") have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 31.06 II (C.), 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in the paragraph apply to all claims currently pending.

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33. Regarding the conditional elements in the claims (see *e.g.* claim 8 which recites that “when a content ID... said utilization-condition storage means updates”), they too have been considered. However, Applicants are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”

35 USC § 112, 6th Paragraph – Invocation Analysis

Means-Plus-Function Element #1

34. It is the Examiner’s position that the “storage means for storing said contents” (“Means-Plus-Function Element #1”) invokes 35 U.S.C. 112 6th paragraph.

- y. Means-Plus-Function Element #1 meets Invocation Step 1 because “means for” is recited.
- z. Means-Plus-Function Element #1 meets Invocation Step 2 because the phrase recites the function of “for storing said contents”. This function will have its ordinary and plain meaning.
- aa. Means-Plus-Function Element #1 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “for storing said contents”.

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bb. The specification fails to directly disclose what structural elements make up Means-Plus-Function Element #1. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

Means-Plus-Function Element #2

35. It is the Examiner's position that the "request means for making a request for utilization of predetermined contents" ("Means-Plus-Function Element #2") invokes 35 U.S.C. 112 6th paragraph.

cc. Means-Plus-Function Element #2 meets Invocation Step 1 because "means for" is recited.

dd. Means-Plus-Function Element #2 meets Invocation Step 2 because the phrase recites the function of "for making a request for utilization of predetermined contents". This function will have its ordinary and plain meaning.

ee. Means-Plus-Function Element #2 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of "for making a request for utilization of predetermined contents".

ff. The specification fails to directly disclose what structural elements make up Means-Plus-Function Element #2. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

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Means-Plus-Function Element #3

36. It is the Examiner's position that the "reception means for receiving a table" ("Means-Plus-Function Element #3") invokes 35 U.S.C. 112 6th paragraph.

gg. Means-Plus-Function Element #3 meets Invocation Step 1 because "means for" is recited.

hh. Means-Plus-Function Element #3 meets Invocation Step 2 because the phrase recites the function of "for receiving a table". This function will have its ordinary and plain meaning.

ii. Means-Plus-Function Element #3 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of "for receiving a table".

jj. The specification fails to directly disclose what structural elements make up Means-Plus-Function Element #3. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

Means-Plus-Function Element #4

37. It is the Examiner's position that the "utilization-condition storage means for storing said utilization condition and said table" ("Means-Plus-Function Element #4") invokes 35 U.S.C. 112 6th paragraph.

kk. Means-Plus-Function Element #4 meets Invocation Step 1 because "means for" is recited.

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ll. Means-Plus-Function Element #4 meets Invocation Step 2 because the phrase recites the function of “for storing said utilization condition and said table”. This function will have its ordinary and plain meaning.

mm. Means-Plus-Function Element #4 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “for storing said utilization condition and said table”.

nn. The specification fails to directly disclose what structural elements make up Means-Plus-Function Element #4. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

Means-Plus-Function Element #5

38. It is the Examiner’s position that the “utilization execution means for executing utilization of said predetermined contents” (“Means-Plus-Function Element #5”) invokes 35 U.S.C. 112 6th paragraph.

oo. Means-Plus-Function Element #5 meets Invocation Step 1 because “means for” is recited.

pp. Means-Plus-Function Element #5 meets Invocation Step 2 because the phrase recites the function of “for executing utilization of said predetermined contents”. This function will have its ordinary and plain meaning.

qq. Means-Plus-Function Element #5 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “for executing utilization of said predetermined contents”.

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rr. The specification fails to directly disclose what structural elements make up Means-Plus-Function Element #5. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

Means-Plus-Function Element #6

39. It is the Examiner's position that the "utilization-condition transmission means for transmitting said table" ("Means-Plus-Function Element #6") invokes 35 U.S.C. 112 6th paragraph.

ss. Means-Plus-Function Element #6 meets Invocation Step 1 because "means for" is recited.

tt. Means-Plus-Function Element #6 meets Invocation Step 2 because the phrase recites the function of "for transmitting said table". This function will have its ordinary and plain meaning.

uu. Means-Plus-Function Element #6 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of "for transmitting said table".

vv. The specification fails to directly disclose what structural elements make up Means-Plus-Function Element #6. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

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Means-Plus-Function Element #7

40. It is the Examiner's position that the "sales-history information storage means for storing sales-history information of said predetermined contents" ("Means-Plus-Function Element #7") invokes 35 U.S.C. 112 6th paragraph.

ww. Means-Plus-Function Element #7 meets Invocation Step 1 because "means for" is recited.

xx. Means-Plus-Function Element #7 meets Invocation Step 2 because the phrase recites the function of "for storing sales-history information of said predetermined contents". This function will have its ordinary and plain meaning.

yy. Means-Plus-Function Element #7 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of "for storing sales-history information of said predetermined contents".

zz. The specification fails to directly disclose what structural elements make up Means-Plus-Function Element #7. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

Means-Plus-Function Element #8

41. It is the Examiner's position that the "collection means for collecting sales records of contents utilized by said terminal" ("Means-Plus-Function Element #8") invokes 35 U.S.C. 112 6th paragraph.

aaa. Means-Plus-Function Element #8 meets Invocation Step 1 because "means for" is recited.

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bbb. Means-Plus-Function Element #8 meets Invocation Step 2 because the phrase recites the function of “for collecting sales records of contents utilized by said terminal”.

This function will have its ordinary and plain meaning.

ccc. Means-Plus-Function Element #8 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “for collecting sales records of contents utilized by said terminal”.

ddd. The specification fails to directly disclose what structural elements make up Means-Plus-Function Element #8. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

Means-Plus-Function Element #9

42. It is the Examiner’s position that the “processing execution means for carrying out processing based on said sales records” (“Means-Plus-Function Element #9”) invokes 35 U.S.C. 112 6th paragraph.

eee. Means-Plus-Function Element #9 meets Invocation Step 1 because “means for” is recited.

fff. Means-Plus-Function Element #9 meets Invocation Step 2 because the phrase recites the function of “for carrying out processing based on said sales records”. This function will have its ordinary and plain meaning.

ggg. Means-Plus-Function Element #9 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “for carrying out processing based on said sales records”.

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hhh. The specification fails to directly disclose what structural elements make up Means-Plus-Function Element #9. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

Means-Plus-Function Element #10

43. It is the Examiner's position that the "acquisition means for acquiring execution-history information" ("Means-Plus-Function Element #10") invokes 35 U.S.C. 112 6th paragraph.

iii. Means-Plus-Function Element #10 meets Invocation Step 1 because "means for" is recited.

jjj. Means-Plus-Function Element #10 meets Invocation Step 2 because the phrase recites the function of "for acquiring execution-history information". This function will have its ordinary and plain meaning.

kkk. Means-Plus-Function Element #10 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of "for acquiring execution-history information".

lll. The specification fails to directly disclose what structural elements make up Means-Plus-Function Element #10. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

Means-Plus-Function Element #11

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44. It is the Examiner's position that the "utilization-history information storage means for storing utilization-history information" ("Means-Plus-Function Element #11") invokes 35 U.S.C. 112 6th paragraph.

mmm. Means-Plus-Function Element #11 meets Invocation Step 1 because "means for" is recited.

nnn. Means-Plus-Function Element #11 meets Invocation Step 2 because the phrase recites the function of "for storing utilization-history information". This function will have its ordinary and plain meaning.

ooo. Means-Plus-Function Element #11 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of "for storing utilization-history information".

ppp. The specification fails to directly disclose what structural elements make up Means-Plus-Function Element #11. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

Means-Plus-Function Element #12

45. It is the Examiner's position that the "favorite extraction means for extracting information of contents" ("Means-Plus-Function Element #12") invokes 35 U.S.C. 112 6th paragraph.

qqq. Means-Plus-Function Element #12 meets Invocation Step 1 because "means for" is recited.

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rrr. Means-Plus-Function Element #12 meets Invocation Step 2 because the phrase recites the function of “for extracting information of contents”. This function will have its ordinary and plain meaning.

sss. Means-Plus-Function Element #12 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “for extracting information of contents”.

ttt. The specification fails to directly disclose what structural elements make up Means-Plus-Function Element #12. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

Means-Plus-Function Element #13

46. It is the Examiner’s position that the “execution-history information storage means for storing execution-history information” (“Means-Plus-Function Element #13”) invokes 35 U.S.C. 112 6th paragraph.

uuu. Means-Plus-Function Element #13 meets Invocation Step 1 because “means for” is recited.

vvv. Means-Plus-Function Element #13 meets Invocation Step 2 because the phrase recites the function of “for storing execution-history information”. This function will have its ordinary and plain meaning.

www. Means-Plus-Function Element #13 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of “for storing execution-history information”.

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xxx. The specification fails to directly disclose what structural elements make up Means-Plus-Function Element #13. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

Means-Plus-Function Element #14

47. It is the Examiner's position that the "execution-history information transmission means for transmitting said execution-history information" ("Means-Plus-Function Element #14") invokes 35 U.S.C. 112 6th paragraph.

yyy. Means-Plus-Function Element #14 meets Invocation Step 1 because "means for" is recited.

zzz. Means-Plus-Function Element #14 meets Invocation Step 2 because the phrase recites the function of "for transmitting said execution-history information". This function will have its ordinary and plain meaning.

aaaa. Means-Plus-Function Element #14 meets Invocation Step 3 because the claim does not recite sufficient definite structure for performing the function of "for transmitting said execution-history information".

bbbb. The specification fails to directly disclose what structural elements make up Means-Plus-Function Element #14. In other words, the corresponding structure is not clearly linked in the written description with the required specificity.

Conclusion

48. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work, Millennium Ed. By Ron White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by Nathan J. Muller, is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these references are directed towards beginners (see *e.g.* “User Level Beginning...”), because of the references’ basic content (which is self-evident upon examination of the references), and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within these references.

49. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s supervisor, Andrew Fischer can be reached at (571) 272-6779.

50. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Jacob C. Coppola/
Patent Examiner, Art Unit 3621
September 24, 2008

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621